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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/760,879 | 01/17/2001 | Naohito Takae | 1341.1077 (JDH) | 4985 |

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| EXAMINER |
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RAMOS FELICIANO, ELISEO

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| ART UNIT | PAPER NUMBER |
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2687

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,879

Applicant(s)

TAKAE ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/29/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28, 2004 has been entered.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement filed on September 29, 2004 have been considered by the examiner (see attached PTO-1449 form).

Drawings

3. **Figures 7 and 8** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see the specification, page 5, lines 10-13). See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3-5, 7-8, 11-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (US Patent Number 6,628,940) in view of the Admitted Prior Art (disclosed on page 1, line 1 to page 3, line 18 and Figures 7 and 8 of the present disclosure) (MPEP 2129).

Regarding **claim 1**, Henrick discloses a portable terminal remote control method of remotely controlling a portable terminal (105, 206, 400, 605) from an external device (101, 201, 601) via a wireless communication link (column 7, lines 41-44), said portable terminal having a main body provided with a built-in memory (database 403 – Figure 4; column 5, lines 61-64; column 2, lines 20-21). See Figures 1-2 & 4-6. (Note "information storage" or "database" (403) reads on "memory" and "cellular telephone terminal" (105, 206, 400, 605) reads on "portable terminal having a main body"). The method including:

accepting a request (call) by said external device related to a change of setting in said portable terminal from a user of said portable terminal via the wireless communication link (column 3, line 63 to column 4, line 7; column 5, lines 58-61; column 6, lines 8-11; column 1, line 66 to column 2, line 18); and

sending a setting changing, by said external device to said portable terminal, in response to the accepted request (column 3, lines 66-67), and

wherein the setting changing includes a computer program ("software" or "firmware"; see column 1, line 11; column 5, lines 9-10 & 30-40; column 10, lines 52-53) that changes contents of the built-in memory, and a setting changing identifier ("indicator"; column 5, lines

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15-21; column 6, lines 10-15) that identifies the setting changing file such that the portable terminal is configured to execute a different function.

However, Henrick fails to disclose that the setting changing is a "setting changing mail" as claimed; that the portable terminal further includes an attachable/detachable storage medium; and that the setting changing mail collectively changes the contents of the built-in memory and the storage medium of the portable terminal, in response to the received request.

The prior art admitted by applicant disclosed on page 1, line 1 to page 3, line 2 and Figures 7 and 8 of the present disclosure (or simply "the Admitted Prior Art" herein) teaches a portable terminal (90 – Figure 8) having a main body (91) provided with a built-in memory (inherent; page 1, lines 13-15), and an attachable/detachable storage medium (SIM card 92 and/or IC card 93). An external device (managing device 80) sends ME, SIM and IC setting changing mail that "collectively" (*that is*, "considered as one group or whole") change the function of the built-in memory and the storage medium of the portable terminal, such that the portable terminal is configured to execute a different function. See e.g. page 2, lines 20-25 of the Admitted Prior Art.

Therefore, it would have been obvious at the time the invention was made to provide Henrick with an attachable/detachable storage medium, as taught by the Admitted Prior Art, and "collectively" changing the contents of the built-in memory and the storage medium in response to the received request for the advantage of data loss prevention by memory backup. In addition, it would have been obvious at the time the invention was made to modify Henrick so that the setting changing is in form of "mail" (electronic mail) because e-mail is easy to use, cost effective, and widely available; therefore, user-friendly and very desirable.

Regarding **claim 3**, see the rejection of *claim 1* for the subject matter this claim is dependent upon. The combination of Henrick and the Admitted Prior Art further disclose that upon acceptance of the request related to the change of setting in said portable terminal, generating the setting changing mail containing a computer program suitable to the received request. (Henrick - column 3, lines 30-38, and column 3, line 67 to column 4, line 9, note whether the "user selects directory or appointments" reads on "suitable"). The information in the setting changing mail is a computer program ("software" or "firmware"; see column 1, line 11; column 5, lines 9-10 & 30-40; column 10, lines 52-53).

Regarding **claim 4**, see the rejection of *claim 3* for the subject matter this claim is dependent upon. The combination of Henrick and the Admitted Prior Art further disclose that upon acceptance of the request related to the change of setting in said portable terminal from the user of said portable terminal, checking whether or not the user is an authorized users get, and generating the setting changing mail only when the user is an authorized user. (The telephone terminal requires a special mode for security and control requiring physical possession of the telephone terminal accomplished by user interface buttons 405 and display 406 of the telephone terminal; inherently: checking whether or not the user is an authorized user. – column 5, lines 42-52 of Henrick).

Regarding **claim 5**, Henrick discloses a portable terminal remote control method of remotely controlling a portable terminal (105, 206, 400, 605) from an external device (101, 201, 601) via a wireless communication link (column 7, lines 41-44), said portable terminal having a main body provided with a built-in memory (database 403 – Figure 4; column 5, lines 61-64; column 2, lines 20-21). See Figures 1-2 & 4-6. (Note "information storage" or "database" (403)

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reads on "memory" and "cellular telephone terminal" (105, 206, 400, 605) reads on "portable terminal having a main body"). The method including:

receiving a setting changing, sent from said external device (101, 201, 601) in said portable terminal (105, 206, 400, 605), the wireless communication link, (column 3, line 63 to column 4, line 7; column 5, lines 58-61; column 6, lines 8-11; column 1, line 66 to column 2, line 18), the setting changing including a computer program ("software" or "firmware"; see column 1, line 11; column 5, lines 9-10 & 30-40; column 10, lines 52-53) that collectively changes contents of the built-in memory, and a setting changing identifier ("indicator"; column 5, lines 15-21; column 6, lines 10-15) that identifies the setting changing;

identifying the setting changing based on the setting changing identifier (indicator; column 5, lines 15-21; column 6, lines 10-15); and

updating the contents of said built-in memory based on the content of the received setting changing such that the portable terminal is configured to execute a different function (column 3, lines 66-67; column 5, lines 58-61; column 6, lines 8-14).

However, Henrick fails to disclose that the setting changing is a "setting changing mail" as claimed; that the portable terminal further includes an attachable/detachable storage medium; and that the setting changing mail collectively changes the contents of the built-in memory and the storage medium of the portable terminal, in response to the received request.

The prior art admitted by applicant disclosed on page 1, line 1 to page 3, line 2 and Figures 7 and 8 of the present disclosure (or simply "the Admitted Prior Art" herein) teaches a portable terminal (90 – Figure 8) having a main body (91) provided with a built-in memory (inherent; page 1, lines 13-15), and an attachable/detachable storage medium (SIM card 92

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and/or IC card 93). An external device (managing device 80) sends ME, SIM and IC setting changing mail that “collectively” (*that is*, “considered as one group or whole”) change the function of the built-in memory and the storage medium of the portable terminal, such that the portable terminal is configured to execute a different function. See e.g. page 2, lines 20-25 of the Admitted Prior Art.

Therefore, it would have been obvious at the time the invention was made to provide Henrick with an attachable/detachable storage medium, as taught by the Admitted Prior Art, and “collectively” changing the contents of the built-in memory and the storage medium in response to the received request for the advantage of data loss prevention by memory backup. In addition, it would have been obvious at the time the invention was made to modify Henrick so that the setting changing is in form of “mail” (electronic mail) because e-mail is easy to use, cost effective, and widely available; therefore, user-friendly and very desirable.

Regarding **claim 7**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick and the Admitted Prior Art further disclose wherein the storage medium includes a subscriber identity module card (SIM card 92 – Admitted Prior Art, Figure 8) issued by a communication provider (inherent), provided with a processor and a memory (by definition of SIM card); so that in the collectively updating of the contents, the main body has a processor that updates the contents of said built-in memory by executing the computer program contained in the setting changing mail (explained above), and the subscriber identity module card is updated by a processor-to-processor communication between the processor in said main body and the processor in the subscriber identity module card (inherent by definition of SIM card).

Regarding **claim 8**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick and the Admitted Prior Art further disclose storing the received setting changing mail in the built-in memory (explained above). In addition, the Admitted Prior Art discloses when the storage medium is replaced with another storage medium (newly inserted SIM card), updating contents of the other storage medium by running the computer program contained in the setting changing mail stored in said internal memory (page 3, lines 12-18).

Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to update the contents of the new storage medium by running the computer program contained in the setting changing mail stored in the internal memory when the storage medium is replaced with another storage medium, for the advantage of transporting information to another phone and/or for data loss prevention by creating multiple backups.

As to **claims 11 and 12**, they are the corresponding system and recording medium claims of method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claim 13**, it is a corresponding system claim of method *claim 5*; therefore, it is rejected for the same reasons applied above for *claim 5*.

As to **claims 14 and 18**, they are method claims corresponding to method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claims 15 and 16**, they are the corresponding system and recording medium claims of method *claim 14*; therefore, they are rejected for the same reasons applied above for *claim 14*.

As to **claim 17**, it is a corresponding system claim of method *claim 4/3/1*; therefore, it is rejected for the same reasons applied above for *claim 4/3/1*.

6. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick and the Admitted Prior Art as applied to **claim 5** above, and further in view of Hubbe et al. (US Patent Number 6,278,885).

Regarding **claim 9**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick and the Admitted Prior Art disclose storing the received setting changing mail in said storage medium (explained above).

However, the combination fails to disclose when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of the main body of the other portable terminal by running the computer program contained in the setting changing mail stored in said storage medium.

However, Hubbe discloses when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of the main body of the other portable terminal by running the computer program (abstract, see also column 3, lines 26-35) contained in the setting changing mail stored in said storage medium (as already discussed in this claim).

Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to add the above teachings of Hubbe et al. to the combination of Henrick and the Admitted Prior Art, to enable a mobile user to, for example, store the directory information in his SIM card to the internal memory of another mobile when the user is using another phone (as suggested by Hubbe, column 4, lines 8-14). Also for the advantage of data loss prevention by creating multiple backups.

Response to Arguments

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7. Applicant's arguments with respect to *claims 1, 3-5, 7-8, and 11-17* have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (703) 306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf
November 19, 2004


ELISEO RAMOS-FELICIANO 11/19/04
PATENT EXAMINER